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SUPPLEMENTAL BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 09/747,656
Attorney Docket No. 031792-0311452 (24122-380)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



IN RE PATENT APPLICATION OF: Eugene J. Rollins *et al.*
SERIAL NO.: 09/747,656
ATTORNEY DOCKET NO: 031792-0311452 (24122-380)
FILING DATE: December 22, 2000
ART UNIT : 3625
EXAMINER ROBERT M. POND
FOR: PROVIDING NAVIGATION OBJECTS FOR COMMUNICATIONS OVER A NETWORK

SUPPLEMENTAL BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

Further to the "*Notification of Non-Compliant Appeal Brief*" mailed **December 15, 2005**, Appellants respectfully submit a Supplemental Appeal Brief on Appeal pursuant to 37 C.F.R. §41.37.

It is believed that no fees are due in connection with the filing of this Supplemental Appeal Brief. In the event that it is determined that fees are due, however, the Director is hereby authorized to charge the undersigned's Deposit Account No. 033975 (**Ref. No. 031792-0311452**).

REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

The real party in interest is E-centives, Inc. by virtue of the assignment recorded on April 11, 2001 at Reel 011680, Frame 0858.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

As recited on page 1 of the Specification, the above-referenced application is related to two commonly-assigned patent applications, the contents of all of which in their entirety have been incorporated by reference. The status of these related, co-pending, and commonly-assigned patent applications is set forth below.

1. U.S. Patent Application Serial No. 09/747,651, filed December 22, 2000, entitled: "Pre-Filing Order Forms for Transactions Over a Communications Network." An Examiner's Answer was mailed in this application on November 1, 2005.

2. U.S. Patent Application Serial No. 09/747,666, filed December 22, 2000, entitled: "Tracking Transactions By Using Addresses In a Communications Network." An "Order Returning Undocketed Appeal to Examiner" was mailed in this application on July 12, 2005.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 1-6 and 9-14 are pending.

Withdrawn: Claims 7-8 and 15-17 are withdrawn.

Rejected: Claims 1-6 and 9-14 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 1-6 and 9-14 are appealed.

IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

No claims have been amended subsequent to the mailing of the Final Office Action on May 11, 2004 (hereinafter "Final Action"). On July 12, 2004, Applicants submitted a Reply Under 37 C.F.R. §1.116 wherein only arguments were presented. An Advisory Action was mailed on August 11, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

The following exemplary citations to the Specification and drawing figures are not exclusive, as other examples of support for claimed subject matter exist. As such, the following citations should not be viewed as limiting.

One aspect of Appellants' invention relates to a system and method for providing navigation objects for communications over a network. According to various implementations, transactions may be processed over a communications link, in part, using an intermediary. A transaction may comprise, for example, a customer purchasing a product from a merchant.

With particular regard to independent claim 1, one aspect of the invention relates to receiving a first request for a first electronic document, wherein the first electronic document is associated with a first address; and providing the first electronic document. As an example, the first request may be from a customer using web browser (302), executing on client (303), and may comprise a request for a first electronic document (*e.g.*, a web page associated with a shopping application). *See* Specification, *e.g.*, pg. 15, lines 10+; and FIG. 3.

One aspect of the invention relates to receiving, by an intermediary, a second request for a second electronic document based upon selection of a first object that is included in the first electronic document, wherein the first object is associated with a second address of the second electronic document; and retrieving the second electronic document. As an exemplary illustration, a first object (*e.g.*, a proxied link) may be included in the first electronic document (*e.g.*, the web page associated with a shopping application). The proxied link may be associated with a second address (*e.g.*, a URL) of a second electronic document (*e.g.*, a corresponding merchant web page). When the proxied link is selected, the request for the corresponding merchant web page may be sent to intermediary ("IOM") (308) instead of the merchant web server. IOM (308) then makes a request to the merchant web server for the corresponding web page. Because IOM (308) requests the web page from the merchant web server, the requested web page is sent to IOM (308) instead of the customer. *See* Specification, *e.g.*, pg. 15, line 20 – pg. 16, line 3; and FIG. 3.

One aspect of the invention relates to generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address. As an example, IOM (308) may modify the second electronic document (*e.g.*, the retrieved

merchant web page) to add a second object (*e.g.*, a navigation object) with a direct link back to the first electronic document (*e.g.*, the original web page associated with the shopping application). *See* Specification, *e.g.*, pg. 16, lines 3-4; pg. 19, lines 5+; and FIGS. 3 and 5A-5B.

One aspect of the invention relates to providing the updated second electronic document in response to the second request for the second electronic document. As an example, the modified web page may then be provided to the client (303). *See* Specification, *e.g.*, pg. 19, line 7.

Accordingly, one aspect of the invention enables customers to return easily to a shopping application from a merchant web page when making purchases over the Internet. "Stickiness" is provided by using IOM (308) to proxy a merchant web page and thereby modify the merchant web page to include a navigation object that provides direct access to the original shopping application. This allows a customer to return easily to a shopping application by selecting a navigation object on a proxied merchant web page, regardless of whether links traversed by the customer have been redirected or "broken." *See* Specification, *e.g.*, pg. 15, lines 10-18.

Independent claim 9 is directed to a computer-readable medium for processing requests for electronic documents, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the functions described in detail above with regard to independent claim 1.

The term "computer-readable medium" may refer to any medium that participates in providing instructions to processor (1004) for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and

transmission media. Non-volatile media includes, for example, optical or magnetic disks, such as storage device (1010). Volatile media includes dynamic memory, such as main memory (1006). Transmission media includes coaxial cables, copper wire and fiber optics, including the wires that comprise bus (1002). Transmission media may also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications. See Specification, *e.g.*, pg. 48; and FIG. 10.

Common forms of computer-readable media include, for example, a floppy disk, a flexible disk, hard disk, magnetic tape, or any other magnetic medium, a CD-ROM, any other optical medium, punch cards, paper tape, any other physical medium with patterns of holes, a RAM, a PROM, and EPROM, a FLASH-EPROM, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read.

Various forms of computer readable media may be involved in carrying one or more sequences of one or more instructions to processor (1004) for execution. For example, the instructions may initially be carried on a magnetic disk of a remote computer. The remote computer can load the instructions into its dynamic memory and send the instructions over a telephone line using a modem. A modem local to computer system (1000) can receive the data on the telephone line and use an infrared transmitter to convert the data to an infrared signal. An infrared detector coupled to bus (1002) can receive the data carried in the infrared signal and place the data on bus (1002). Bus (1002) carries the data to main memory (1006), from which processor (1004) retrieves and executes the instructions. The instructions received by main memory (1006) may optionally be stored on storage device (1010) either before or after execution by processor (1004). Specification, *e.g.*, pgs. 48-49; and FIG. 10.

Further description of network communications may be found in the Specification at pgs. 49-50, and with reference to FIG. 10.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

Claims 1-6 and 9-14 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,016,504 to Arnold *et al.* ("Arnold"). See Final Action, pg. 2, ¶1.

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

Claims 1-6 and 9-14 are patentable under 35 U.S.C. § 102(e) over Arnold for at least the reason that Arnold fails to disclose each and every claim element. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, MPEP §2131.02 states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent Claims 1 and 9

Independent claims 1 and 9 recite, *inter alia*, the feature of "generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address." Emphasis Added. Arnold does not appear to disclose *at least* this feature.

In the Final Action, the Examiner apparently relies on the disclosure in Arnold of a

virtual outlet as the intermediary recited in the claims. However, the virtual outlet disclosed in Arnold does not generate an updated second electronic document that includes a second object associated with the first address. Apparently, a merchant computer in Arnold modifies a merchant web page to contain a return link so that the customer may return to the web page of the virtual outlet upon completion of a purchase. *See* Arnold, *e.g.*, col. 4, lines. 20-24. Furthermore, Arnold apparently discloses an operation wherein an updated electronic document is generated at the merchant site. *See* Arnold, *e.g.*, col. 7, lines 54-65.

In the Advisory Action mailed August 11, 2004, the Examiner refers to column 6 of Arnold in an attempt to show that Arnold discloses the feature of generating an updated second electronic document by the intermediary. Appellants disagree. The passage of Arnold relied upon by the Examiner apparently discloses that a return address can be sent as part of the URL used by the customer to access the merchant Web site, and that this URL is supplied to the customer as a hot link within the virtual outlet web page. However, this is not a second updated electronic document generated by the intermediary, as disclosed and claimed by Appellants. By contrast, it appears to be a link to the merchant website. For *at least* this reason, Arnold does not appear to disclose *at least* these features of the invention. Thus, claims 1 and 9 are not anticipated by Arnold.

Dependent Claims 2-6 and 10-14

Appellants further submit that dependent claims 2-6 and 10-14 are allowable because they depend from allowable independent claims, as well as for the further features they contain.

VIII. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 1-6 and 9-14) are attached in **APPENDIX A**.

IX. EVIDENCE APPENDIX - 37 C.F.R. §41.37(c)(1)(ix)

APPENDIX B: None.

X. RELATED PROCEEDINGS APPENDIX - 37 C.F.R. §41.37(c)(1)(x)

APPENDIX C: None.

CONCLUSION

For at least the foregoing reasons, Appellants request that the rejection of claims 1-6 and 9-14 under 35 U.S.C. §102(e), be reversed.

Date: **January 6, 2006**

Respectfully submitted,

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APPENDIX A: CLAIMS APPENDIX

1. **(Previously Presented)** A method for processing requests for electronic documents, the method comprising the computer-implemented steps of:
 - receiving a first request for a first electronic document, wherein the first electronic document is associated with a first address;
 - providing the first electronic document;
 - receiving, by an intermediary, a second request for a second electronic document based upon selection of a first object that is included in the first electronic document, wherein the first object is associated with a second address of the second electronic document;
 - retrieving the second electronic document;
 - generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address; and
 - providing the updated second electronic document in response to the second request for the second electronic document.
2. **(Original)** The method of claim 1, wherein the second object is a hyperlink.
3. **(Original)** The method of claim 1, wherein the updated second electronic document is a web page.

4. **(Original)** The method of claim 1, wherein the first electronic document is a first web page, the second electronic document is a second web page, the updated second electronic document is an updated second web page, and the second object is a hyperlink to the first web page.

5. **(Original)** The method of claim 1, wherein
the first electronic document is a first web page that is associated with a shopping application,

the second electronic document is a second web page that is associated with a merchant,

the updated second electronic document is an updated second web page that is generated by the shopping application, and

the second object is a hyperlink to the first web page.

6. **(Original)** The method of claim 1, further comprising the steps of:

receiving a third request for a third electronic document based upon selection of a third object that is included in the second electronic document, wherein the third object is associated with a third address of the third electronic document;

retrieving the third electronic document;

generating an updated third electronic document that includes a fourth object that is associated with the first address of the first electronic document; and

providing the updated third electronic document in response to the third request for the third electronic document.

7. **(Withdrawn)** A method for processing requests for electronic documents, the method comprising the computer-implemented steps of:

receiving a request for an electronic document that includes one or more relative addresses of one or more other electronic documents;

retrieving the electronic document;

generating a revised electronic document by updating one or more of the one or more relative addresses to specify one or more absolute addresses of the one or more other electronic documents; and

providing the revised electronic document in response to the request for the electronic document.

8. **(Withdrawn)** A method for processing requests for electronic documents, the method comprising the computer-implemented steps of:

receiving, at an intermediary, a request for an electric document that includes at least one document address of one or more other electronic documents;

retrieving the electronic document;

generating, at the intermediary, a revised electronic document by creating at least one modified document address for at least one of the one or more other electronic documents, wherein the modified document address includes both the document address and an intermediary address associated with the intermediary; and

providing the revised electronic document in response to the request for the electronic document.

9. **(Previously Presented)** A computer-readable medium for processing requests for electronic documents, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving a first request for a first electronic document, wherein the first electronic document is associated with a first address;

providing the first electronic document;

receiving, by an intermediary, a second request for a second electronic document based upon selection of a first object that is included in the first electronic document, wherein the first object associated with a second address of the second electronic document;

retrieving the second electronic document;

generating, by the intermediary, an updated second electronic document that includes a second object associated with the first address; and

providing the updated second electronic document in response to the second request for the second electronic document.

10. **(Original)** The computer-readable medium of claim 9, wherein the second object is a hyperlink.

11. **(Original)** The computer-readable medium of claim 9, wherein the updated second electronic document is a web page.

12. **(Original)** The computer-readable medium of Claim 9, wherein the first electronic document is a first web page, the second electronic document is a second we page, the updated second electronic document is an updated second web page, and the second object is a hyperlink to the first web page.

13. **(Original)** The computer-readable medium of claim 9, wherein:
 the first electronic document is a first web page that is associated with a shopping application,
 the second electronic document is a second web page that is associated with a merchant,
 the updated second electronic document is an updated second web page that is generated by the shopping application, and
 the second object is a hyperlink to the first web page.

14. (Original) The computer-readable medium of claim 9, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

receiving a third request for a third electronic document based upon selection of a third object that is included in the second electronic document, wherein the third object is associated with a third address of the third electronic document;

retrieving the third electronic document;

generating an updated third electronic document that includes a fourth object that is associated with the first address of the first electronic document; and

providing the updated third electronic document in response to the third request for the third electronic document.

15. **(Withdrawn)** A computer-readable medium for processing requests for electronic documents, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving a request for an electronic document that includes one or more relative addresses of one or more other electronic documents;

retrieving the electronic document;

generating a revised electronic document by updating one or more of the one or more relative addresses to specify one or more absolute addresses of the one or more other electronic documents; and

providing the revised electronic document in response to the request for the electronic document.

16. (Withdrawn) A computer-readable medium for processing requests for electronic documents, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving, at an intermediary, a request for an electronic document that includes at least one document address of one or more other electronic documents;

retrieving the electronic documents;

generating , at the intermediary, a revised electronic document by creating at least one modified document address for at least one of the one or more other electronic documents, wherein the modified document address includes both the document address and an intermediary address associated with the intermediary; and

providing the revised electronic document in response to the request for the electronic document.

17. **(Withdrawn)** A system for processing requests for electronic document, the system comprising:

an intermediary that is associated with a first electronic document having a first address; and

a server that is associated with a second electronic document having a second address;

wherein the intermediary receives a request for the second electronic document based upon selection of a first object that is included in the first electronic document,

wherein the first object is associated with the second address, and

wherein the intermediary receives the second electronic document from the server and generates, in response to the request for the second electronic document, an updated second electronic document that includes a second object associated with the first address.

APPENDIX B

EVIDENCE APPENDIX - 37 C.F.R. §41.37(c)(1)(ix)

None.

APPENDIX C

RELATED PROCEEDINGS APPENDIX - 37 C.F.R. §41.37(c)(1)(x)

None.